

## **REMARKS**

Claims 1-23 are pending in the present application. Claims 1, 7, 10-12, 18-20 and 23 have been amended herewith. Reconsideration of the claims is respectfully requested.

Applicants are submitting herewith replacement sheets for Figures 6 and 7.

### **I. Specification**

The Examiner objected to the disclosure, stating (1) Figure 6, element 654 is instead referenced in the disclosure as element 656, and (2) Figure 7, element 710 is instead referenced in the disclosure as element 712. Applicants are submitting concurrently herewith replacement sheets for Figures 6 and 7 which correct these element numbers such that they match the numbers used in the disclosure. Thus, the objection to the disclosure has been overcome.

### **II. 35 U.S.C. § 103, Obviousness**

A. The Examiner rejected Claims 1-5, 10, 12-16, 21 and 23 under 35 U.S.C. § 103 as being unpatentable over Bernth et al. (5,737,617). This rejection is respectfully traversed.

Generally speaking, the cited Bernth reference teaches a technique for allowing a user to *manually* update a file with suggested changes. In contrast, the claimed invention is directed to an *automated* technique for expanding terms in a document, which is particular advantageous for impaired individuals such as those visually impaired or temporarily impaired (such as a user driving a car, who is thus otherwise primarily occupied with such driving) who cannot conveniently co-act with a manual editing system such as is taught by Bernth.

Specifically with respect to Claim 1, such claim has been amended to emphasize the automated nature of the term expansion process – which is particularly advantageous for use by impaired user's (either permanent or temporary) who cannot fully interact with a document editing system. In contrast, the teachings of the cited reference require user interaction to manually edit/update a document that is first processed using a batch mode operation to parse the document and identify exceptions (col. 6, line 39 – col. 7, line 21).

The fact that a prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). There is simply no suggestion in the cited reference of any desire to modify the teachings therein in accordance with the invention recited in Claim 1. Thus, it is urged that amended Claim 1 is not obvious in view of the cited reference.

As further enablement of the automated methodology of Claim 1, such claim includes specification of the annotation file by the document for which term expansion is being performed on, which allows for automated receiving of such document without further user interaction. In contrast, the cited reference does not teach any type of receiving of an annotation file, whether specified by the document or otherwise determined. Instead, the cited reference teaches use of pre-existing, fixed rules embedded within a central (i.e. not received) rule module (Figure 2, block 36). Because these rules are pre-existing, fixed and internally contained within the rules module, there would have been no reason or other motivation to include specification of an annotation file (which is received) in the document which is the subject of the term expansion. Thus, amended Claim 1 is further shown to not be obvious in view of the cited reference.

Applicants initially traverse the rejection of Claims 2-5 and 10 for similar reasons to those given above with respect to Claim 1 (of which Claims 2-11 depend upon).

Further with respect to Claim 10, such claim has been amended to recite that the method recited in Claim 1 is performed by a web browser plug-in, which advantageously allows for use of a standard web browser tool – as augmented by a plug-in - for performing the term expansion. In contrast, the cited reference teaches a highly customized and specialized set of tools (Figure 2, elements 30-36). Thus, amended Claim 10 is further shown to not be obvious in view of the cited reference.

With respect to Claim 12, such claim has been amended to specifically recite that the transcoder accesses two files, which advantageously allows for adaptability in providing customized term expansion using an external annotation model (Specification page 2, lines 21-31; page 4, lines 3-9). In contrast, the cited reference teaches use of fixed, internal rules for use by a rules engine (col. 3, lines 11-37). In addition, Claim 12 has been amended to further define specifics of the claimed annotation file, where the

properties and corresponding values describe the expansion terms to be used in the term expansion process. In contrast, the cited reference merely teaches use of internal rules within a rules module for performing exception identification, where unified parse structures are sequentially explored (col. 3, lines 29-37). There is no teaching or suggestion of a separately received file having properties and corresponding values that describe the expansion terms to be used in the term expansion process. Thus, amended Claim 12 is shown to not be obvious in view of the cited reference, as there are numerous claimed features not taught or suggested by the cited reference.

Applicants traverse the rejection of Claims 13-16 and 21 for similar reasons to those given above with respect to Claim 12 (of which Claims 13-16 and 21 depend upon).

With respect to Claim 23, such claim has been amended to recite that the claimed computer program product is a plug-in for a web browser, which advantageously allows for use of a known browser tool – augmented by an appropriate plug-in – to provide users with a common look and feel interface when performing the term expansion within a document. The cited reference teaches use of a highly specialized operating environment for manual user editing of a file (Figure 2). Because the Bernth system is primarily directed to a text authoring system (col. 1, lines 5-10), which was not commonly known to be a primary function of a browser (such a browser was instead commonly known as providing a browsing function), a person of ordinary skill in the art would not have been motivated to modify the teachings of Bernth to include such a browser as a part of such text authoring system. Thus, it is urged that amended Claim 23 is not obvious in view of the cited reference, as the fact that a prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification. *In re Gordon*, supra.

Further with respect to Claim 23, Applicants urge that the cited reference does not teach or otherwise suggest any instructions for *receiving an annotation file* having one or more term expansions (which is used for term replacement). Rather, the cited reference teaches use of a fixed, hard-coded and pre-existing rules module (Figure 2, element 36) for use in identifying exceptions (col. 3, lines 29-38). Thus, Claim 23 is further shown to not be obvious in view of the cited reference.

Therefore, the rejection of Claims 1-5, 10, 12-16, 21 and 23 under 35 U.S.C. § 103 has been overcome.

**B.** The Examiner rejected Claims 6-9 and 17-20 under 35 U.S.C. § 103 as being unpatentable over Bernth et al. (5,737,617), and in further view of Miller (An Introduction to the Resource Description Framework). This rejection is respectfully traversed.

Applicants initially traverse the rejection of Claim 6-9 (and similarly for Claims 17-20) for similar reasons to those given above with respect to Claim 1 (of which Claims 6-9 depend upon).

Further with respect to Claim 6 (and similarly for Claim 17), Applicants urge that none of the cited references teach or suggest *replacing terms in a hypertext markup language document*. In rejecting Claim 6, the Examiner states that Miller teaches that a document is from the World Wide Web, and thus it is obvious that the document has hypertext markup language. Applicants show error in such assertion, as Miller describes a resource description framework environment, which is a model for describing resources (page 3, last paragraph). It does not teach or otherwise suggest any type of document that has its terms replaced, and thus it follows that it does not teach or otherwise suggest that such (missing) document (that has terms replaced therein) comprises a hypertext markup language document, as expressly recited in Claim 6. Although a device may be capable of being modified to run the way [the patent applicant's] apparatus is claimed, there must be a suggestion or motivation *in the reference* to do so. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). There is simply no suggestion or motivation per the teachings of Miller to modify such teachings to include a document for which terms are replaced using an annotation file, where the document (which is the subject of the term replacing step) comprises a hypertext markup language document. Thus, Claim 6 is further shown to not be obvious in view of the cited references.

Further with respect to Claim 9 (and similarly for Claim 20), Applicants urge that none of the cited references teach or suggest the claimed feature of “wherein a property of the one or more properties and the value corresponding to the property describe the expansion terms”. In rejecting Claim 9, the Examiner states that Miller teaches this

claimed feature per figure 3, where Author\_001 is expanded into Affiliation, Name and Email. Applicants urge that per Claim 9, 'the property' describes the expansion terms that are used for term replacement. The Affiliation, Name and Email are not used for term replacement *in a different file* (the received document), as expressly recited by Claim 9 (in combination with independent Claim 1). Rather, they further define the property-type of Author (page 4, last paragraph) within the RDF model description itself. How this model or its defined information is used by other processes or files is not taught or otherwise described. Thus, it is urged that Claim 9 has been erroneously rejected under 35 U.S.C. § 103, as all of the claim limitations are not taught or suggested by the prior art. MPEP 2143.03.

Further with respect to Claims 19 and 20, such claims have amended per the Specification description at page 15, lines 11-21 to recite further optional customization of the term replacement methodology to advantageously guide the automated term replacement process. Since the cited reference teaches a manual text editing system, there would be no need or other motivation to modify the teachings contained therein to include such claimed features. Thus, Claims 19 and 20 are further shown to not be obvious in view of the cited references.

Therefore, the rejection of Claims 6-9 and 17-20 under 35 U.S.C. § 103 has been overcome.

C. The Examiner rejected Claims 11 and 22 under 35 U.S.C. § 103 as being unpatentable over Bernth et al. (5,737,617), and in further view of Bernardes (6,292,773). This rejection is respectfully traversed.

Applicants initially traverse the rejection of Claim 11 for similar reasons to those given above with respect to Claim 1 (of which Claim 11 depends upon). Further with respect to Claim 11, such claim has been amended to recite that the term replacement step is optionally performed based upon a user's identity, as described at Specification page 16, lines 19-29, which advantageously allows for system behavior customization based upon particular needs of a given individual. Because the cited reference teaches a user who *manually* edits a document, there is no need to identify a user to customize any

*automated* operational steps according to special user needs/requirements. Thus, amended Claim 11 is further shown to not be obvious in view of the cited reference.

Applicants traverse the rejection of Claim 22 for similar reasons to those given above with respect to Claim 11.


Therefore, the rejection of Claims 11 and 22 under 35 U.S.C. § 103 has been overcome.

### **III. Conclusion**

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: 5/4/05

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "D. Yee", is written over a horizontal line.

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